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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 09/862,472  | 05/23/2001  | John C. Cofano       | GT10004US                       | 7470                        |
| 29150   | 7590        | 06/27/2007           |                                 |                             |
| LEE & HAYES, PLLC<br>421 W. RIVERSIDE AVE<br>STE 500<br>SPOKANE, WA 99201 |             |                      | EXAMINER<br>BROOKS, MATTHEW L   |                             |
|   |             |                      | ART UNIT<br>3629                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>06/27/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhpto@leehayes.com

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/862,472 | <b>Applicant(s)</b><br>COFANO ET AL. |  |
|                              | <b>Examiner</b><br>Matthew L. Brooks | <b>Art Unit</b><br>3629              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 16-21 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7, 9, 16-21 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. With respect to the claims:

Claim 1 → step g it is confusing as to why the claim states “recording interactions while providing the selection”... should it not state ... “recording interactions while providing the *personal services*”?

Claims 16, 17, 18 → “....the service response is determined based...” Is it not just really based on?

### *Claim Rejections - 35 USC § 112 2<sup>nd</sup>*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to **Claim 1 (for example and 19)**, with respect to steps a-d Applicant has truly convoluted the definitions/meanings of the terms group, member and user. For instance looking to step (a) receiving a request from a user who is a member, then in step (b) determine a user type, is that not already been done by knowing the user is a member? Further in step (c) providing a menu of service options corresponding to the determined user type *and group membership*? So is a member also a user type?

Now also due to amendments made Applicant is missing an essential step. In the preamble Applicant states this is a “method of providing personalized services over a computer network”, now Applicant fails to ever provide personalized services and in fact only *enables* a system to do so, see steps (e) and (f).

Further, there is a lack of antecedent basis for “...the determined service response” in step (f) because it has never been “determined”.

Moreover it is indefinite and confusing as to the difference between a “service response” and a “personal service” And applicant confuses the issue further later on in the claims because (ie) in claim 2 personal services are laid out.

Lastly with respect to step (i) it is indefinite as to how the administrator is associated with the one group. This becomes even more confusing because a “user” as in claim 3, can also be an administrator. Is this person providing personal services and statistical information to him/herself

4. With respect to **claim 2** although now personal service response is given meaning it is still indefinite as to what is a “service response”. Further Applicant states “...further comprising enabling delivery of at least on healthcare-related recommendation to the user.” This fails to limit because this has already been accomplished in claim 1 step (f) that of providing personal services.

5. With respect to claim 4 there is a lack of antecedent basis for “the menu of service option requests comprises...”

6. With respect to **claim 5 and 6 and 7** when the user type is a service provider, administrator, research services what are the “personal services” provided?

7. With respect to **Claim 9**, line 14 it is indefinite as to what is “service provided”. Is it personal service? Also on the same line does it record “user *type* requesting service? With respect to line 15 “provided by user and/or service provider” does the user provide to herself? And with respect to “performance metrics” this subject matter was cancelled from the claims.

8. With respect to **Claim 16 and 17 and 18**, first note that in claims 17 there is a lack of antecedent basis for “the service response”. Furthermore the term itself service response is indefinite. What is the difference between that term and “personal service”; which in Claim 18 is what is likely based on information related to an estimated condition of a user?

9. Claims 1-18 were analyzed only for purposes of prosecution the same analysis applies to the subsequent claims 19-21 and 25-27 where appropriate, please fix accordingly in response.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-7 and 9 and 16-18 and 19-21 and 25-27** are rejected under 35 U.S.C. 102(b) as being clearly taught by Patent No.: 6,283,761 (Joao).

12. With respect to **Claim 1 and 19 and 20**: Joao discloses

A computer implemented method of providing personal services over a computer network to members of at least one of a plurality of predefined groups, the method comprising the steps of (C 41, 35-40)

a. receiving a service request from a user who is a member of one of the groups (C25, 5-65; C4, 38-40 "can be used by any party"; C39, 55-60; C39,10-20);

b. determining a user type associated with the service request (C25, 5-65; C4, 38-40 "can be used by any party"; C39, 55-60; C39,10-20);

c. providing a menu of service request options corresponding to the determined user type (C25, 5-65; C4, 38-40 "can be used by any party"; C39, 55-60; C39,10-20);

d. receiving a selection of one of the service request option from the user (C39, 10-20 "user responses")

e. enabling a service response to the service request to be determined based on the service request option selected by the user (C14, 12-20);

f. enabling personal services to be provided to the user in accordance with the selected service request option and the determined service response (C14, 12-20);

g. recording interactions while providing the selection (C39, 10-20 and C7, 12-15); and

h. inserting at least one reminder related to the personal services into an electronic calendar associated with the user (C32, 65-68 "update providers schedule" and C33, 15-20 "reminder and C24, 25-30 and C5, 10-18 and C5, 35-40 and C6, 20-25 and C6, 50-55 and C3, 1-14"); and

i. presenting statistical information related to the interactions to an administrator associated with the one group (C5, 50-60 and C9, 15-20 and C20, 15-25 and C28, 40-45 and C19, 20-28 and C38, 45-55).

13. With respect to **Claim 2**: Joao discloses

wherein the personal services comprises healthcare related services, wherein the groups are respective employers, wherein the user is an employee of one of the employers and is receiving the healthcare related services (C14, 12-20 and C36, 12-16); and

further comprising delivering at least one healthcare-related recommendation to the user, wherein the communication is defined based on rules applicable to the interactions. (C14, 12-20 and C36, 12-16).

14. With respect to **Claim 3**: Joao discloses

wherein the user type comprises one of a member/employee, a service provider, an administrator, a research service, and a service partner (C2, 55-60; C4, 32-58; C26, 39-44 and C28, 10-18).

15. With respect to **Claim 4**: Joao discloses

wherein if the user type is member/employee, the menu of service option requests comprises view services available, news, communication, update/create user profile, schedule appointment, immediate consultation, perform transaction, check status, provide feedback/comments ((C2, 55-60 and C18, 50-55 and C25, 5-10).

16. With respect to **Claim 5**: Joao discloses

wherein if the user type is service provider the menu of service request options comprises news, knowledge base, administration, feedback query, and communication (C2, 55-60).

17. With respect to **Claim 6**: Joao discloses

wherein if the user type is administrator, the menu of service request options comprises news, initiate query, communications, and help request (C25, 5-60 and C18, 50-55 "news" and C37, 35-40 and C41, 34-40).

18. With respect to **Claim 7**: Joao discloses

wherein if the user type is research services the service request options comprise news, accessible databases, and queries (C19, 40-46 and C7, 31-40 and C39, 10-20 and C25, 5-60 and C18, 50-55 "news" and C37, 35-40 and C41, 34-40).

19. With respect to **Claim 9**: Joao discloses

wherein recording interactions includes storing information regarding type of service provided, user requesting service, service provider information and recommendations, frequency of service provided by user and/or service provider, ~~outcome information~~, feedback from user, and performance-metrics (C4, 20-26 and C39, 10-20 and C39, 28-36).

20. With respect to **Claim 16**: Joao discloses

further comprising enabling a service response is determined based on information related to a medical history of the user (Besides being inherent actually shown at C32, 47-48).

21. With respect to **Claim 17**: Joao discloses



wherein the service response is determined based on information related to a work schedule of the user (Besides being inherent actually shown at C32, 47-48).

22. With respect to **Claim 18**: Joao discloses

wherein the service response is-to be determined based on information related to an estimated condition of the user(Besides being inherent actually shown at C32, 47-48 and C38, 34-40.

23. **Claims 19-21 and 25-27** being the system for the method are based on the same analysis.

#### ***Response to Arguments***

24. Applicant's arguments filed 3/7/2007 (Remarks) have been fully considered but they are now moot and/or not persuasive.

#### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. [www.e-med.com](http://www.e-med.com) retrieved from the wayback machine and can be pulled back with a date up to 1 year before filing date and before Applicant's provisional.

B. Pub. No.: US 2002/0065682 A1 (Goldneberg).

C. Patent No.: 5,517,405 (McAndrew) → Teaches automatic rule engine diagnosis of patient on line and recording thereof in database; also see C2 for knowledge base, news, and recommendations

D. [www.bestdoctors.com](http://www.bestdoctors.com) from wayback machine which can be pulled as far back as 1/25/1999.


E. Patent Nos.: 5,301,105 and 6,283,761 and 5,553,609

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB  
6/2/07



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